IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In Re Application of: Confirmation No.: 5349

    Anthony J. Wasilewski   Group Art Unit: 2431

Serial No.: 10/602,988   Examiner: Chai, Longbit

Filed: June 25, 2003   Docket No.: 60374.0029USC9/CPOL 968511

For: Method for Partially Encrypting Program Data

REPLY BRIEF UNDER 37 C.F.R. § 41.41 IN RESPONSE TO EXAMINER'S ANSWER

Mail Stop: Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Appellants hereby submit a brief in reply to the Examiner's Answer dated

November 10, 2009, in the patent application identified above. A Notice of Appeal was

filed on June 3, 2009, and an Appeal Brief was filed on August 3, 2009.

REPLY

The arguments presented in the Appeal Brief are hereby incorporated by reference in their entirety.

Claims 1-12 and 15-20 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 7,376,233 ("*Candelore*") with *incorporated by reference* of U.S. Pat. Pub. No. 2003/0026423 ("*Unger*"). Claims 13-14 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Candelore* in view of U.S. Patent No. 7,216,358 ("*Vantalon*").

In the Appeal Brief, Appellants traversed these rejections by illustrating that since the claims of the present application enjoy the benefit of a filing date that predates the effective filing date of *Candelore* (and *Unger*), the art of record does not represent anticipatory subject matter, and accordingly, the rejection should be withdrawn.

In the Examiner's Answer, the Examiner responds that the "disclosure of the prior-filed application, for example, the immediate parent CON Application No. 09/930,901 flied {sic} on 16 August 2001...fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application such as 'encrypting a first portion of the selected digital bit stream according to a first encryption method to provide a first encrypted stream; encrypting a second portion of the selected digital bit stream according to a second encryption method to provide a second encrypted stream wherein the second encryption method is different from the first encryption method;' as recited in claim 1" (Examiner's Answer, p. 7-8).

Specifically, Examiner admits that a number of applications for which the present application claims priority disclose that "Any part or all of MPEG-2 transport stream may be encrypted..." (See, Answer, p. 8; U.S. Pat. No. 6,937,729, col. 18, lines, 54-55; Provisional U.S. Application No. 60/054,575, p. 28, lines 25-26). It is undisputed by the Examiner that the present application makes the same disclosure. (Present Application, at p. 27, lines 19-29). However, the Examiner's Answer then states that these disclosures of encrypting all or a portion of an MPEG-2 transport stream do not mean what they say. Appellants respectfully disagree.

The plain language of these cited documents mimics the plain language of the present application. As such, the Examiner relies not on an issue of priority, but rather that neither the present application nor any of the priority documents disclose "encrypting a first portion of the selected digital bit stream according to a first encryption method to provide a first encrypted stream and encrypting a second portion of the selected digital bit stream according to a second encryption method to provide a second encrypted stream wherein the second encryption method is different from the first encryption method".

Claim 1 requires "encrypting a first portion of the selected digital bit stream according to a first encryption method to provide a first encrypted stream," and "encrypting a second portion of the selected digital bit stream according to a second encryption method to provide a second encrypted stream wherein the second encryption method is different from the first encryption method." Appellants wish to draw attention to page 13, lines 6-16 of the specification, which is used in conjunction with Figure 3. Figure 3 and the above-noted specification portion reveals a digital bit

stream (e.g., transport stream) comprising ECM encrypted according to 3DES (e.g., 321) and audio/video/data content coded according to DES (e.g., 327). Such a disclosure would be readily evident to one having ordinary skill in the art that different encryption methods for the same stream, different portions, are contemplated. In addition, page 27 of the specification (lines 19-29), used in conjunction with Figure 7, describes detailed mechanisms of MPEG transport, and in particular, the fact that "any part or all of MPEG transport stream" may be encrypted, revealing to one having ordinary skill in the art that the stream may comprise clear and encrypted portions (i.e., partially encrypted). Note that one encryption method is described as the DES algorithm (for the program), and on page 28, lines 15-22, the ECMs are encrypted according to a different method (3DES), consistent with the previously described portions of the specification pertaining to Figure 3.

Such a disclosure in the present application is clearly supported by disclosure of encrypting any part or all of MPEG-2 transport stream as shown in the priority documents. The Examiner points to embodiments disclosed in the priority documents that he argues limits the reading of the clear disclosure that "any part or all of MPEG-2 transport stream may be encrypted...". (Answer, p. 8-10). First, it is noted that the specification is not limited to the particular embodiments cited by Examiner. Second, the priority documents make a clear statement that any part of the MPEG-2 may be encrypted. The priority documents discuss individual bit streams in detail and nowhere does the specification limit the encryption to entire bit streams as suggested by the Examiner.

Accordingly, it is clear that the specification supports the above-recited claim 1 elements, and to the extent such elements are found in identical or similar form in claim 13, Appellants respectfully request that the priority denial be withdrawn. In addition, since the current application is a continuation along a line of continuations having an effective priority date of July 8, 1998, the effective filing date at least goes back to July 8, 1998. Although Appellants respectfully disagree with the allegations pertaining to the alleged unpersuasiveness of the affidavits in related cases (and hence believe priority can be dated back to the provisional application date of August 1, 1997), the issue of support in the provisional is moot for purposes of the present rejection and the *Candelore* and *Unger* references.

Since the claims of the present application enjoy the benefit of a filing date that predates the effective filing date of *Candelore* (and *Unger*), the art of record does not represent anticipatory subject matter, and accordingly, the rejection should be withdrawn.

For at least the reason that independent claims 1, 7, and 15 are allowable over the cited references of record, respective dependent claims 2-6, 8-14, and 16-20 are allowable as a matter of law.

CONCLUSION

In closing, Appellants respectfully submit that the rejected claims define patentable subject matter over the applied art and request the Board to reverse the rejections of those claims.

While no fees are believed due, the Commissioner is authorized to charge any additional required fees to our deposit account 13-2725.

Respectfully submitted,

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Date: January 11, 2010

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